

Cigelske, James J. Jr.

U.S. Serial No. 10/065,774.

TRAVERSAL REMARKS

In the Office Action mailed June 16, 2003, the Examiner set forth a three-way restriction of claims 1-20. As noted above, Applicant has elected claims 1-8 and 15-20 of Group I. Applicant believes, however, that the restriction of claims 9-11 and 12-14 to be improper in light of the similarities between that which is called for in each claim group.

The Examiner identified claims 1-8 and 15-20 as being drawn to a portable welding apparatus and classified the claims in class 174, subclass 52.1. Claims 9-11 were identified as being drawn to a shield and classified in class 361, subclass 212. The Examiner identified claims 12-14 as being drawn to a method of providing electrical shielding apparatus and classified the claims in class 29, subclass 840.

With respect to the restriction of Groups I and II, the Examiner indicated that inventions I and II are related as combination and subcombination. Specifically, the Examiner asserts that, "[I]n the instant case, the combination as claimed does not require the particulars of the subcombination as claimed such as the apparatus does not require the shield being inverted U-shaped." The Examiner adds, "[T]he subcombination has separate utility such as the shield can be used with other electrical devices." Applicant disagrees that these distinctions warrant restriction.

MPEP §806.05(c), provides restriction is proper "[w]here a combination as claimed does not set forth the details of the subcombination as separately claimed and the subcombination has separate utility, the inventions are distinct and restriction is proper if reasons exist for insisting upon the restriction; i.e., separate classification, status, or field of search" (emphasis added). MPEP §806.05(c). Reasons for insisting upon restriction may be shown by a separate classification thereto, a separate status in the art when they are classifiable together, and a different field of search. MPEP §808.02.

Applicant agrees that claim 1 of Group I does not set forth the details of the subcombination as defined by claim 9 of Group II. However, as provided by MPEP §806.05(c), the Examiner must also provide reasons for insisting upon restriction. The Examiner states that a reason for insisting upon the restriction is "[b]ecause these

Cigelske, James J. Jr.

U.S. Serial N . 10/065,774

inventions . . . have acquired a separate status in the art as shown by their different classification."

MPEP §808.02 provides that the Examiner may establish a reason for insisting on restriction based on a separate classification of the inventions. That is, the Examiner may show "that each distinct subject has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search" (emphasis added). *Id.* Therefore, to insist upon restriction on this basis, the Examiner is relying on the separate classification of the inventions to suggest that separate searches are required.

Applicant appreciates that the Examiner must conduct a thorough review of the application when classifying the claims. However, Applicant believes the classification assigned by the Examiner to each of the groups fails to consider the similarities therebetween. Specifically, claim 1 calls for, in part, an electrical shield at least partially surrounding an internal stud to prevent arcing between said internal stud and an electrically conducted component or metal enclosure. Thus, the scope of claim 1 is directed to a device that discharges or prevents accumulation of electric charge. It appears that the Examiner has grouped claims 1-8 and 15-20 in class 174, subclass 52.1 simply because the preamble is directed to a portable welding apparatus. However, upon review of the elements of claims 1-8 and 15-20, it is clear that the respective inventions are directed toward an electrical or non-conductive shield for discharging or preventing accumulation of electric charge. Thus, it would appear that class 361, subclass 212 to be a more appropriate classification for the claims of Group I.

As the Examiner has grouped claims 9-11, drawn to a shield, in class 361, subclass 212, Applicant respectfully believes that, at a minimum, the claims of Groups I and II should be rejoined and examined in the present application.

Claims 12-14 were classified in class 29, subclass 840 as being drawn to a method of providing electrical shielding apparatus. Again, Applicant believes the Examiner has improperly classified the invention of Group III. That is, class 29, subclass 840 is directed to a "process wherein a portion of the electrical component or of a terminal attached thereto is composed of metal and further wherein the portion is either raised to a

Cigelske, James J. Jr.

U.S. Serial No. 10/065,774

fusible temperature or subjected to metal in a fused state thereby effecting bonding of the electrical component to the base". See Manual of Patent Classification. Simply put, class 29, subclass 840 is directed to or covers inventions that relate to metal fusion such as welding. However, claim 12 is directed to a method of providing electrical shielding - not welding. Further, the elements of the claims call for affixing an electrical shield to an internal surface of end panel to at least partially surround an electrical stud by fitting the electrical shield into ribs to shield the electrical stud against arcing to conductive components or a conductive enclosure. Claim 12 does not call for metal fusion as suggested by the classification assigned by the Examiner. Further, the Examiner's classification of Group III into class 29, subclass 840 appears to unduly limit the scope of claims 12-14. As such, Applicant is concerned that a search of class 29, subclass 840, with respect to the invention of claims 12-14, may not be as extensive and exhaustive as needed to ascertain the patentability of claims 12-14.

Additionally, claims 12-14 positively call for the affixing of an electrical shield to an internal surface of an end panel. As set forth in claim 12, the shield is constructed to prevent arcing to conductive components or a conductive enclosure. As such, Applicant believes that class 361, subclass 212 which covers or is directed to inventions relating to the discharging or preventing accumulation of electrical charge, to be a more appropriate classification for the invention of Group III. Furthermore, in light of the Examiner's classification of claims 9-11 in class 361, subclass 212, Applicant respectfully believes that, at a minimum, claims 12-14 should be rejoined with claims 9-11 for examination in the present application.

Additionally, Applicant believes that a search of one group of claims would necessarily include a search of the other claim groups. That is, a search of claims 1-8 and 15-20 would necessarily include a search of that called for in claims 5-7 as well as claim 16. Claims 5-7 further define the electrical shield of claim 1 as having a generally U-shaped configuration. Claim 16 further defines the at least three planar sides of the non-conductive shield as having a generally U-shaped configuration. Similarly, claim 9 of Group II positively calls for a U-shaped configuration for the shield. Therefore, a search

Cigelske, James J. Jr.

U.S. Serial No. 10/065,774

of claims 1-8 and 15-20 would necessarily include a search of the invention of claims 9-11. As such, the search of claim 1-8 and 15-20 would be coextensive of the search for claims 9-11. Accordingly, claims 1-8 and 15-20 should be rejoined with claims 9-11 for examination in the present case.

Further, claim 13 of Group III further defines the electrical shield of claim 12 as having a generally U-shaped configuration. As such, a search of claims 1-8 and 15-20 of Group I would necessarily include a search of that called for in claim 13 of Group II. As such, Applicant believes that claims 12-14 should be rejoined with claims 1-8 and 15-20 of Group I and claims 9-11 of Group II for examination in the present application.

The Examiner further restricted Group I, claims 1-8 and 15-20, and Group III, claims 12-14, as process of making and product made under MPEP §806.05(f). A product "can be restricted from the process if the examiner can demonstrate that the product as claimed can be made by another materially different process." MPEP §806.05(f).

The Examiner stated that "[i]n the instant case the apparatus does not the internal surface having a plurality of ribs." Both Group I and Group III call for, in part, a plurality of ribs extending outwardly from the end panel. In particular, claim 18 of Group I calls for "the portable welding apparatus of claim 15 wherein the end panel has a plurality of ribs extending outwardly proximate the electrical stud and the non-conductive shield is affixed to the end panel by being interfitted within the ribs." Claim 12 of Group III, in part, calls for:

providing a portable welding apparatus comprising a conductive enclosure having an end panel, the end panel having an external surface and an internal surface to form an enclosed space with the conductive enclosure to contain conductive components, the end panel having an electrical terminal having a receptacle on the external surface and an electrical stud on the internal surface, the internal surface having a plurality of ribs extending outwardly therefrom. (emphasis added)

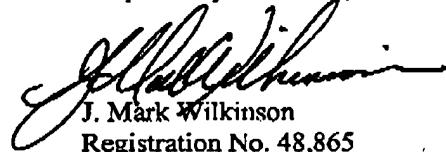
The apparatus of Group I, therefore, is not "made by another and materially different process" as claimed in Group III. Further, a search of claims 12-14 with respect to the "ribs" called for in claim 12, would necessarily include a search of the inventions

**Cigelske, James J. Jr.****U.S. Serial No. 10/065,774**

of claims 1-8, and 15-20. That is, claim 4 and claim 18 of Group I call for a plurality of ribs. As such, Applicant believes that the restriction of Groups I and III is improper. Applicant requests that Groups I and III be rejoined and that the restriction be withdrawn.

Therefore, Applicant believes that claims 1-20 should be rejoined for examination and consideration in the present application. The Examiner is invited to call the undersigned to discuss this Restriction Requirement or any other matters regarding this application.

Respectfully submitted,



J. Mark Wilkinson  
Registration No. 48,865  
Direct Dial 262-376-5016  
[jmw@zpspatents.com](mailto:jmw@zpspatents.com)

Dated: July 15, 2003  
Attorney Docket No.: ITW7510.029

**P.O. ADDRESS:**  
Ziolkowski Patent Solutions Group, L.L.C.  
14135 N. Cedarburg Rd.  
Mequon, WI 53097-1416  
262-376-5170